



Docket No. AT9-98-464

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nuxoll et al.

Serial No.: 09/215,752

Group No.: 2151

Filed: December 18, 1998

Examiner: Courtenay III, S.

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For: Method and Apparatus for a Meta Data Service in a Data Processing System

Assistant Commissioner for Patents
Washington, D.C. 20231

ATTENTION: Board of Patent
Appeals and Interferences

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July 25, 2001

By:

Lizzy Perkins
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APPELLANT'S REPLY BRIEF (37 C.F.R. 1.192)

This brief is in reply to the Examiner's Answer, dated 25 May 2001.

The fees required under § 1.17(c), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL DOCUMENT.

This brief is transmitted in triplicate. (37 C.F.R. 1.192(a))

ARGUMENTS

REJECTION UNDER 35 U.S.C. 102(e)

The Office Action rejects claims 1, 2, 5, 7, 10, 13, 14, 16, 18-20, 22, 24-35, 37, 40, 42, and 46 under 35 U.S.C. 102(e) as being anticipated by *Maruyama et al.* (U.S. 5,710,920), hereinafter referred to as “*Maruyama*.” This rejection is respectfully traversed.

The Examiner’s Answer states:

- Appellant argues that *Maruyama* does not teach “identifying attributes in the meta definition” and “prompting a user to input data values corresponding to the object attributes” [brief, page 5, last paragraph].

Examiner’s response:

The Examiner has applied a broad, but reasonable interpretation, to the claimed meta definition and object “attributes.” The Examiner notes that the term “meta data” is widely used in the art to broadly denote “data about data.” “Object Attributes” reasonably and broadly denote any data or variable associated with an object. “Object Attributes” are explicitly disclosed by *Maruyama* [e.g., see discussion beginning col. 3, line 11]. By Appellant’s own admission, *Maruyama* “teaches an object-oriented database in which an object may be changed in terms of attribute, relation, and procedure, independently of schema,” and *Maruyama* teaches that “Meta data is stored in a database for objects in the object-oriented database” [brief, page 8, last paragraph].

“Meta definition information” is explicitly disclosed by *Maruyama* [e.g., see discussion beginning col. 3, line 29, also same column, line 61; also see col. 4, line 10, line 24, line 43, line 60; also see col. 5, line 4, line 17, line 29]. *Maruyama* teaches user interaction with the view manager 101 wherein the user supplies a command and data [e.g., see discussion beginning col. 3, lines 44-47], such interaction inherently displaying command and data entry fields that prompt the user for input, as is routinely implemented in computer user interfaces, as taught by *Maruyama*.

Examiner’s Answer, dated 25 May 2001. Examiner’s arguments are confusing. Clearly, the issue is not whether objects have attributes. The issue is whether *Maruyama* teaches “identifying attributes in the meta definition” and “prompting a user to input data values

corresponding to the object attributes,” as argued. The cited portion of *Maruyama* states:

A view manager 101 is a section which converts an object defined by the user into a structure (view) the user wants to see so as to offer the structure to the user and receives a command and data from the user.

Maruyama, col. 3, lines 44-47. The above portion describes an embodiment for appending, deleting, and updating a characteristic (attribute, relation, or procedure) of an object. The changes are stored as parts objects. See *Maruyama*, col. 3, lines 32-40. As such, a user changes the definition of an object and these changes, including changes to attributes, are stored as parts objects. *Maruyama* does not teach “identifying attributes in the meta definition” and “prompting a user to input data values corresponding to the object attributes.”

Examiner appears to respond by stating that the method steps are inherent and routine. Appellant respectfully disagrees. The examiner has misapplied the concept of "inherent" anticipation. Section 102 of Title 35 deals with novelty and loss of patent rights. An invention is said to be "anticipated" when it is squarely described or disclosed in a single reference as identified from one of the categories of 35 U.S.C. § 102, commonly referred to as "prior art". Express anticipation occurs when the invention is expressly disclosed in the prior art, patent or publication. In some cases, however, when the claimed invention is not described *in haec verba*, the "doctrine of inherency" is relied on to establish anticipation. Under the principles of inherency, a claim is anticipated if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986). A prior art reference that discloses all of a patent's claim limitations anticipates that claim even though the reference does not expressly disclose the "inventive concept" or desirable property the patentee discovered. *Verdgaal Brothers, Inc. v. Union Oil Company of California*, 814 F.2d 628, 2 U.S.P.Q.2d 1051, (Fed. Cir. 1987). It suffices that the prior art process inherently possessed at that property. *Id.* Mere possibilities or even probabilities, however, are not enough to establish inherency. The missing claimed

characteristics must be a "natural result" flowing from what is disclosed. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference are inherent when they exist as a "matter of scientific fact". *Constant v. Advanced MicroDevices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988). Otherwise, the invention is not inherently anticipated.

In the present case, the examiner's assertion that these elements are present can be made only through the use of the applicants' disclosure as a template to fill in the missing elements. In fact, the reference concerns an embodiment for changing the definition or schema of an object, but does not teach or suggest prompting a user for **values** corresponding to attributes of an object.

Furthermore, *Maruyama* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent, the examiner pointing out some teaching or incentive to implement *Maruyama* to receive a meta definition at a software component for an object, identify object attributes in the meta definition, and prompting a user to input data values corresponding to the object attributes, one of ordinary skill in art would not be led to modify *Maruyama* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Maruyama* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicants' disclosure as a template to make the necessary changes to reach the claimed invention. All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Since the references individually do not teach or suggest the limitations relied upon in the rejection, the combination of references cannot render the claims unpatentable.

The Examiner's Answer also states:

The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the claims *as broadly as reasonably possible* during prosecution. *In re Prater*, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969). For the reasons detailed above, the Examiner maintains that the

generic terms “meta data” and “meta definition” and “object attribute” are reasonably subject to a broad interpretation and that *Maruyama* does teach the claimed limitations as detailed in the rejections copied above.

Examiner’s Answer, dated 25 May 2001. Appellant respectfully disagrees. The examiner’s duty does not stop with interpretation of terms found in the claims. The reference must teach each and every method step to anticipate the claims. Appellant maintains that *Maruyama* fails to teach or suggest “identifying attributes in the meta definition” and “prompting a user to input data values corresponding to the object attributes,” as specifically recited, in combination, in claim 1.

The Examiner’s Answer states:

- Appellant argues that *Maruyama* does not teach where “an application receives an object in a soft format (data value stream) and queries a Meta Data Service for the meta definition. [brief, page 7, first paragraph]. The Examiner notes that a “soft format” is not claimed, and that a data value stream can be reasonably and broadly interpreted to be any transfer of data between software components.

Examiner’s Answer, dated 25 May 2001. Appellant respectfully disagrees. The examiner declares that the term “data value stream” may be interpreted broadly to mean “any transfer of data between software components.” However, if the reference teaches a transfer of data that includes meta data for the data, then there is no need to retrieve a meta definition from a Meta Data Service or to map data values to a data structure according to attributes in a received meta definition. Again, the examiner defends the interpretation of terms within the claims without pointing out where in the prior art the recited steps are shown. Appellant maintains that *Maruyama* fails to teach or suggest receiving a data value stream, sending a query for a meta definition of a data object, receiving the meta definition, and mapping data values to a data structure according to the attributes in the meta definition of the data object, as alleged in the rejection.

The Examiner’s Answer states:

- Appellant argues that *Maruyama* does not teach the claimed Meta Data Service [brief, page 9, first line].

Examiner's response:

Appellant concedes that *Maruyama* does teach that Meta Data is stored in a database for objects in the object-oriented database [brief, page 8, last paragraph]. Again, the Examiner notes that the term "meta data" is widely used in the art to broadly denote "data about data."

Examiner's Answer, dated 25 May 2001. Appellant respectfully disagrees. Again, the examiner appears to focus on interpreting the claim language broadly enough to read on the reference. However, the examiner does not point out where in the reference the claimed steps are taught. *Maruyama* teaches a method for allowing a user to change the meta definition or schema of an object type in an object-oriented database. *Maruyama* does not teach or suggest using a Meta Data Service for providing meta definitions for "prompting a user for input data values corresponding to object attributes" or "processing the data object according to attributes in the meta definition to form a data value stream," as recited in claims 1 and 35 from which claims 5 and 40 depend.

REJECTION UNDER 35 U.S.C. 103(a)

The Examiner's Answer states generally that Appellant argues that the instant invention would not have been obvious and responds with case law that is generally concerned with obviousness. Appellant does not disagree with the case law set forth in the Examiner's Answer. However, the Examiner's Answer does not specifically address any of the remarks set forth in the Appeal Brief. Thus, Appellant maintains that the rejections are improper.

The Examiner's Answer notes that Appellant failed to seasonably challenge the Official Notice, pursuant to the requirements set forth under MPEP §2114.03. This argument is confusing, because Appellant has not challenged the taking of Official Notice at all. Rather, Appellant maintains that, even though limitations such as a cache are generally known the rejection does not present a *prima facie* case of obviousness. Again, the Examiner's Answer does not specifically address any of the remarks set forth in the Appeal Brief. Thus, Appellant maintains that the rejections are improper.

CONCLUSION

In view of the above, Appellant respectfully submits that all of the rejections of claims 1, 2, 4-7, 10-14, 16, 18-20, 22, and 24-27 are overcome. Accordingly, it is respectfully urged that the examiner's rejections of claims 1, 2, 4-7, 10-14, 16, 18-20, 22, and 24-27 not be sustained.

Respectfully submitted,

Date

25 July 2001



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Group Art Unit: 2151

Examiner: Courtenay III, S.

Attorney Docket No.: AT9-98-464

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By: Lizzy Perkins
Lizzy Perkins

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Assistant Commissioner of Patents
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Sir:
ENCLOSED HEREWITH:

- Appellant's Reply Brief (in triplicate); and
- Return postcard.

No fees are believed to be necessary at this time. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to **IBM CORPORATION DEPOSIT ACCOUNT NO. 09-0447**. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested. Please charge the fee for this extension to Deposit Account No. 50-0392.

Respectfully submitted,

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